



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,907	04/20/2004	Michael T. Barrett	10031034-1	5662

22878 7590 10/11/2006

AGILENT TECHNOLOGIES INC.
INTELLECTUAL PROPERTY ADMINISTRATION, M/S DU404
P.O. BOX 7599
LOVELAND, CO 80537-0599

EXAMINER

CHO, DAN SUNG C

ART UNIT PAPER NUMBER

1634

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,907

Applicant(s)

BARRETT ET AL.

Examiner

Dan-Sung C. Cho

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a method of using an array for a comparative genomic hybridization, classified in class 435, subclass 6.
 - II. Claim 17, drawn to a process of making an array, classified in class 435, subclass 91.5.
 - III. Claims 19-22, drawn to a method of array data use, classified in class 436, subclass 94.
 - IV. Claims 18, drawn to an array, classified in class 435, subclass 287.2.
 - V. Claims 23-25, drawn to a composition, classified in class 435, subclass 287.2.
 - VI. Claims 26-28, drawn to a kit, classified in class 435, subclass 287.2.
 - VII. Claims 29-31, drawn to a computer-based medium and its usage, classified in class 702, subclass 19.
 - VIII. Claims 32, drawn to a computer method, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and II are directed to related methods. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the

Art Unit: 1634

inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are (1) of different design, mode of operation, function as Claim I is a method of using an array and II, a process of array fabrication; (2) of no overlapping scope because of different design and mode of operation; and (3) of no obvious variants. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

2. Inventions I and III are directed to unrelated methods. Invention I does not require a method of data transmission of invention III. Inventions IV and V are directed to unrelated products. Invention IV is drawn to an array while V, to a composition. Invention IV encompasses use of a support that Invention V does not.

3. Inventions IV and VI are directed to unrelated products. Invention IV is drawn to an array while VI, to a composition. Invention IV encompasses use of a support that Invention VI does not. Inventions IV and VII or VIII are directed to unrelated products. Invention IV is drawn to an array while VII, to a computer medium and VIII, a computer. Invention IV encompasses use of a support that Inventions VII and VIII do not. Inventions VII and VIII are unrelated because VII is drawn to a computer medium and VIII to a computer method.

4. Inventions I and IV; I and V; I and VI are related as process of use and a product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially

Art Unit: 1634

different process of using that product. See MPEP § 806.05(h). In the instant case for example the array can be used to detect gene expression profiles.

5. Inventions I and VII or VIII are directed to an unrelated product and process.

Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, Claim VII or VIII, drawn to computer or computer medium and its usage cannot be made by Claim I, drawn to a method of using array.

6. Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case comparative genomic hybridization array can be made without including any polynucleotide element identified using aCGH but identified by subtractive DNA library screening.

7. Inventions II and V; II and VI; II and VII or VIII are unrelated because II is drawn to a method of making an array that V to VIII are not capable of being used together.

8. Invention III and IV are related as product and a process of use. In the instant case for example the array can be used without data transmission of IV. III and V; III and VI and III and VII or VIII are unrelated. Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, Invention VII or VIII,

Art Unit: 1634

drawn to computer or computer medium and its usage cannot be made by III, drawn to a method of array data usage.

9. Inventions IV and V; IV and VI; and IV and VII or VIII are directed to unrelated products. Each invention is distinct having a materially different design, mode of operation, function, or effect. Inventions as claimed have a materially different design, mode of operation, function, or effect in that invention IV is drawn to an array that requires a support V, VI do not require.

10. V and VI; V and VII or VIII are directed to unrelated products. Each invention is distinct having a materially different design, mode of operation, function, or effect. Inventions as claimed have a materially different design, mode of operation, function, or effect in that invention V is drawn to a composition encompasses a kit manual while VI to VIII do not require.

11. VI and VII or VIII are unrelated. VI has different design as a kit with nucleic acid while VII and VIII encompass computer or computer medium.

12. VII and VIII are related as process of use and a product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case for example computer medium can be used to detect gene expression profiles.

13. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

Art Unit: 1634

because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Notice of Possible Rejoinder

14. Group II and IV, the examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

15. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

Art Unit: 1634

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

CONCLUSION


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan-Sung C. Cho whose telephone number is 571-272-9933. The examiner can normally be reached on Mon - Fri, 7-4 EST.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dan-Sung C. Cho
Examiner
AU1634



RAM R. SHUKLA, PH.D.
SUPERVISORY PATENT EXAMINER